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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,112	11/13/2003	Mitsumasa Tsuchiya	019519-409	7708

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,112

Applicant(s)

TSUCHIYA ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-23 with respect to the elected and applied species is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 16-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/901,676.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

This is in response to Paper filed on 15 November 2004.

- I. Applicants elect species of compound Y-1 on page 48 of the specification without traverse being acknowledged. The elected species has been considered and searched. The consideration and search are extensive to the applied species. Others have not considered, searched or examined until all of the elected and applied species are overcome.
- II. The amendment filed 13 November 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The language "chelating agent containing a divalent metal" in claim is not found to be support from the originally filed application Serial No 09/901,676.

Applicant is required to cancel the new matter in the reply to this Office Action.

- III. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The language "chelating agent containing a divalent metal" is not found to be support
form the originally filed application Serial No 09/901,676.

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However, the language “chelating agent to a divalent metal” is found in the originally filed claim 4 only.

IV. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-19 and 22-23 with respect to the elected and applied species are rejected under 35 U.S.C. 102(b) as being anticipated by Nogami et al (5,122,438).

Nogami et al disclose and teach an aqueous alkaline developing solution comprising up to 10 wt% of at least one nonionic aromatic ether surfactant (of Formulas 1, 2 and 3 with R in Formulas 1 and 3 being a phenyl group having a alkyl group substituent at col.4:13-24) being read on the claimed general formula (I-A), from 0.1 to 20 wt% by weight of an inorganic alkaline agent selected from carbonate and silicate and mixture thereof to sufficiently provide a pH solution of 10 or more at col.4:67 to 5;15, from 20 to 97 wt% of water at col.4:60-61. Since Nogami et al disclose and teach the claimed embodiments, they are found to be anticipated by Nogami et al.

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 16-19 and 21-23 with respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Nogami et al (5,122,438).

Nogami et al disclose, teach and suggest an aqueous alkaline developing solution comprising up to 10 wt% of at least one nonionic aromatic ether surfactant (of Formulas 1, 2 and 3 with R in Formulas 1 and 3 being a phenyl group having a alkyl group substituent at col.4:13-24) being read on the claimed general formula (I-A), from 0.1 to 20 wt% by weight of an inorganic alkaline agent selected from carbonate and silicate and mixture thereof to sufficiently provide a pH solution of 10 or more at col.4:67 to 5;15, from 20 to 97 wt% of water at col.4:60-61.

With respect to the property of “an electrical conductance...” in claim 21, it is not cited in Nogami et al. But, it is reasonable that the same or substantially the same solution (since it contains the same or substantially the same requisite chemical ingredients as clearly pointed out above) that would have the same or substantially the same electrical conductive property as claimed.

Since Nogami et al disclose, teach and suggest an aqueous alkaline developing solutions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite a reasonable expected electrical conductive property of the instant claims to those in Nogami et solutions since the instantly claimed solutions and Nogami et al solutions are the same or substantially the same since they contain the same or substantially the same requisite chemical ingredients and their amounts as clearly pointed out above.

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IV. Applicants' prior art submission filed on 13 November 2003 has been considered to the extension of the English language being provided as those in the parent application.

V. Tanka et al (4,820,621) and Sakurai et al (6,180, 322 as submitted) disclose, teach and suggest compounds being read on the general formulas (I-A) and (I-B). None of them is applied because patentees fail to disclose, teach and suggest their amount of 2 wt% as claimed. Other references on the record are cumulative to the above applied references. They may be later applied when a claim is amended.

VI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
10 January 2004

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Hoa Van Le", written in a cursive style.